



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/805,779

03/22/2004

John F. Joseph

03278.0236

9928

26712

7590

12/12/2007

HODGSON RUSS LLP

THE GUARANTY BUILDING

140 PEARL STREET

SUITE 100

BUFFALO, NY 14202-4040

EXAMINER

CHAWLA, JYOTI

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

12/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/805,779	Applicant(s) JOSEPH ET AL.	
	Examiner Jyoti Chawla	Art Unit 1794	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 16-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/6/04, 9/13/05 &amp; 4/14/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of Group I in the reply filed on September 21, 2007 is acknowledged, i.e., claims 1-15. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 1-7 and 16-20 have been cancelled and elected claims 8-15 and 21-24 are pending and examined in the application. This Election is made FINAL.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-15 recite percentages of triglyceride and emulsifiers etc in claim 1 and each of the dependent claims of the whippable composition, however it is unclear as to whether these proportions are based on weight of the composition, or dry weight or volume before whipping or volume after whipping or some other measure. Clarification and/or correction is required.

Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. Claim 15 is indefinite for the recitation of "composition listed in table 2", as table 2 is not recited in the claims (i.e., the missing element) it is unclear as to what composition is being referred to in claim 15.

Art Unit: 1794

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Determining the scope and contents of the prior art.

Ascertaining the differences between the prior art and the claims at issue.

Resolving the level of ordinary skill in the pertinent art.

Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

(A) Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch (US 6203841).

Lynch teaches of whippable food compositions comprising of about 31% triglyceridic fats (Column 20, lines 25-45) as instantly claimed. Lynch also teaches of 0.1 to 5% emulsifiers, such as, polysorbate 60, and polysorbitan mono and distearate which include Polysorbate 80 and sodium steroyl lactylate and various combinations as

Art Unit: 1794

instantly claimed (Column 9, line 15 to Column 10, line 5) . Lynch also teaches of 0 -2% stabilizers and bulking agents and hydrophilic colloids (Column 9, lines 40-55) as instantly claimed. Lynch also teaches that the whippable composition that is smooth, non-greasy texture and free of waxy mouthfeel (Columns 10-12 and claim 26), as instantly claimed.

Lynch reference does not specify that each of the emulsifiers polysorbate 60 and polysorbate 80 are at least 0.01% as instantly claimed, however, Lynch teaches of emulsifiers in the range recited by the applicant. Lynch also teaches of various emulsifiers and their combinations (Column 9). Further it is noted that polysorbate 80 is a polyoxyethylene ester (Lynch Column 9, lines 23-40) and has been known as an emulsifier for food. Therefore it would have been a matter of routine determination and optimization on the part of one of ordinary skill in the art at the time of the invention to specify polysorbate 80 and also provide a minimal amount of each of the emulsifiers added to the whippable composition. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to specify the name and amount of each of the components of an emulsifier composition as it would be describing one art recognized specific compound (i.e., polysorbate 80) for another general compound category (i.e. polyoxyethylene ester) in the aerated or whipped or whippable confection as disclosed by Lynch, depending on which emulsifying agents were more available and affordable at the time the invention was made.

Lynch teaches of triglyceridic fats in about 31% which falls with the applicant's recited amount (Column 20) for claims 2-3.

Lynch teaches of partially hydrogenated palm kernel oil and coconut oil (Column 5, lines 40-65) as recited in claims 4-5. Lynch also teaches that hydrogenated soy oil can also be used in making the whippable composition (Column 2, lines 40-45) as recited in claim 6.

Regarding the specific relative amounts of emulsifiers (claims 7-8) Lynch reference does not specify that each of the emulsifiers polysorbate 60 and polysorbate 80 do not

Art Unit: 1794

exceed 0.15% as instantly claimed, however, Lynch teaches of emulsifiers in the range recited by the applicant. Lynch also teaches of various emulsifiers and their combinations (Column 9). Further it is noted that polysorbate 80 is a polyoxyethylene ester (Lynch Column 9, lines 23-40) and has been known as an emulsifier for food. Therefore it would have been a matter of routine determination and optimization on the part of one of ordinary skill in the art at the time of the invention to specify polysorbate 80 and also provide a minimal amount of each of the emulsifiers added to the whippable composition. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to specify the name and amount of each of the components of an emulsifier composition as it would be describing one art recognized specific compound (i.e., polysorbate 80) for another general compound category (i.e. polyoxyethylene ester) in the aerated or whipped or whippable confection as disclosed by Lynch, depending on which emulsifying agents were more available and affordable at the time the invention was made.

Regarding claims 9 -10 Lynch teaches of 0 -2% stabilizers and bulking agents and hydrophilic colloids (Column 9, lines 40-55) as instantly claimed.

Regarding claims 11-13, Lynch teaches of addition of Sodium steroyl lactylate (Column 9, lines 35-40). Regarding the specific amount of emulsifiers (Sodium steroyl lactylate) Lynch reference does not specifically provide relative proportions, as instantly claimed, however, Lynch teaches of emulsifiers in the range recited by the applicant. Lynch also teaches of various emulsifiers and their combinations (Column 9). Further it is noted that Sodium steroyl lactylate (Lynch Column 9, lines 35-40) and has been known as an emulsifier for food. Therefore it would have been a matter of routine determination and optimization on the part of one of ordinary skill in the art at the time of the invention to specify the amount of Sodium steroyl lactylate and other emulsifiers added to the whippable composition. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to specify the name and amount of each of the components of an emulsifier composition as it would be describing one art

recognized specific compound (i.e., Sodium steroyl lactylate) for another general compound category (i.e., emulsifiers) in the aerated or whipped or whippable confection as disclosed by Lynch, depending on which emulsifying agents were more available and affordable at the time the invention was made. Further, attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in fact situation of the instant case. At page 234, the Court stated as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients, which produces a new, unexpected and useful function. In *re Benjamin D. White*, 17 C.C.P.A. (Patents) 956, 39 F.2d 974, 5 USPQ 267; In *re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

Regarding claim 14, Lynch teaches of whippable composition comprising sugar (Column 9, line 50-55).

Regarding claim 15, Lynch teaches of whippable food product as recited (Columns 3-12 and Column 20).

### **Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jyoti Chawla whose telephone number is (571) 272-8212. The examiner can normally be reached on 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jyoti Chawla  
Examiner  
Art Unit 1794

  
KEITH D. HENDRICKS  
SUPERVISORY PATENT EXAMINER